

## REMARKS

Applicants acknowledge the Examiner's amendment of the current Office Action from a Final Action to a Non-Final Action per a telephone conversation of December 10, 2004.

Claims

Claims 1-10 are pending. Claims 6-7 are withdrawn and claims 8-9 are cancelled. Applicants acknowledge allowance of claims 1, 3-5, and 10. Claim 2 stands rejected.

Claim 2 has been amended and is supported throughout the specification as filed, for example, at page 14, Table 1; at page 15, lines 12 to 15 and at page 16, lines 5 to 7.

Specification

Applicants acknowledge, with thanks, the Examiner's withdrawal of the objection to the specification under 35 U.S.C. §132.

35 U.S.C. § 112 Rejection

With respect to the rejection of claims 1-5 and 10 under 35 U.S.C. §112, first paragraph, applicants acknowledge withdrawal of the new matter rejection.

Claim 2 stands rejected under 35 U.S.C. §112, first paragraph for lack of enablement. The Examiner has acknowledged that the specification is enabling for the antagonists of claim 1 and those on page 15 of the specification; however, the Examiner has alleged that the specification does not reasonably provide enablement for "antagonists in which potentially every amino acid can be substituted." The Examiner alleged that only guidance and working examples of changing L- to D- amino acids and a couple of specific changes (G-A and G-P) have been provided and, therefore, due to this alleged lack of guidance, it is not predictable to the artisan what changes can be made to the peptides to maintain their functional characteristics.

Applicants respectfully traverse the Examiner's contentions that the specification merely provides guidance and working examples of changing L- to D- amino acids and a couple of specific changes (G-A and G-P). Rather, the specification provides guidance and working examples for a variety of amino acid substitutions and deletions that can be made to the exemplary peptide sequences provided in Table 1 in order to make other peptide antagonists directed against the prostaglandin F2 receptor (see, for example, page 15, line 10 to page 16, line 9 of the specification). As noted by the Examiner, claim 2, currently on file prior to the amendments made herein, specifies that the claimed peptides are antagonists of the prostaglandin F2 receptor.

In addition to describing various variant peptide sequences, the instant specification further provides methods for testing candidate peptides for their ability to act as antagonists of the prostaglandin F2 receptor. For example, the specification at page 6, line 35 to page 7, line 22 and Example 1 at page 10, line 7 to page 11, line 17, describes *in vitro* methods for testing the ability of the candidate peptides to alter signal transduction dependent on the prostaglandin F2 receptor and Examples 2 to 6, at page 11, line 20 to page 17, line 33 of the specification describe *ex vivo* methods to test the ability of candidate peptides to inhibit prostaglandin F2 receptor function. Accordingly, Applicants assert that a worker skilled in the art, in light of the teaching provided in the specification, could readily make the claimed peptides having variant sequences and test these peptides for their ability to act as prostaglandin F2 receptor antagonists without undue experimentation. As stated in the MPEP at § 2164.06 a considerable amount of experimentation may be employed without it being considered undue: "[A]n extended period of experimentation may not be undue if the skilled artisan is given sufficient direction or guidance." *In re Colianni*, 195 USPQ 150, 153 (CCPA 1977). Applicants

submit that the instant specification provides “sufficient direction or guidance” with respect to the preparation and testing, both *in vitro* and *ex vivo*, of the claimed peptide antagonists. In order, however, to expedite prosecution of the instant application, Applicants have amended the language of claim 2 to more clearly define the claimed subject matter. Specifically, claim 2 has been amended to replace “consisting essentially of” with “consisting of” and to specify that “one or two” amino acid residues are substituted or deleted. Support for the amendments may be found throughout the specification as filed, for example, at page 14, Table 1; at page 15, lines 12 to 15 and at page 16, lines 5 to 7. Applicants assert that amended claim 2 complies with 35 U.S.C. § 112, first paragraph. Reconsideration and withdrawal of this 35 U.S.C. §112, first paragraph rejection is respectfully requested.

Applicants acknowledge, with thanks, the withdrawal of claim 3 under 35 U.S.C. §112, second paragraph in view of Applicants’ previous amendments to the claim.

#### 35 U.S.C. §102 Rejection

With respect to claims 1 and 5, Applicants acknowledge, with thanks, the Examiner’s withdrawal of the 35 U.S.C. §102 rejection in view of previous amendments to the claims.

#### CONCLUSION

Based on the foregoing amendments and remarks, Applicants respectfully request reconsideration and withdrawal of the rejection of claims and allowance of this application. It is believed that this application is now in condition for allowance. An action passing this case to issue is courteously urged.

In the event that the Examiner is of the opinion that further discussion of the application would be helpful, the Examiner is hereby respectfully requested to telephone

applicants' undersigned representative at (212) 415-8517 and is assured of full cooperation in an effort to advance the prosecution of the instant application and claims to allowance.

AUTHORIZATION

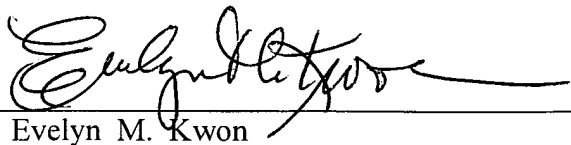
The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 13-4500, Order No. 4591-4000. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4591-4000. A DUPLICATE OF THIS DOCUMENT IS ATTACHED.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: March 2, 2005

By:



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